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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,109	10/29/1999	Jacques Paris	GEI-073	6348

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EXAMINER	
QAZI, SABIHA NAIM	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/423,109	PARIS ET AL.	
	Examiner	Art Unit	
	Sabiha Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *24 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *3,4,7,8,13,18-21,25,26,30 and 31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *3, 4, 7, 8, 13, 18-21, 25, 26, 30 and 31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

3.02

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/04 has been entered.

2. Claims 3, 4, 7, 8, 13, 18-21, 25, 26, 30 and 31 are pending. Rejection under 112 (1) and 35 USC § 112 are maintained in part. No claim is allowed. Amendments are entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3, 4, 7, 8, 13, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Following reason apply:

5. Claim 18 as amended contains "correcting estrogen deficiencies" which was not found i the disclosure and is considered new matter. The word "correcting" is broad and lack a written description.

The specification provides no guidance, in the way written description, that how the Correcting estrogen deficiencies" would work.

6. Claims 19-26 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Following reason apply:

There is no support for "preventing osteoporosis" in the disclosure. This is also considered "new matter".

See In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also In re Wright, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is because it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result."

A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the composition of the compounds fall within the scope of a claim

will possess the alleged activity. See In re Riat et al. (CCPA 1964) 327 F2d 685, 140 USPQ 471; In re Barr et al. (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

As stated above, the true fact of the state of the art that the inventions as claimed cannot be predicted but must be determined from the case to case by painstaking experimental study. When the above factors are weighed together, one of ordinary skill in the art would be burdened with undue "painstaking experimentation study" to determine the compositions as claimed for all the estrogen, progestin, and folic acid combinations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patent ability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 4, 7, 8, 13, 18-21, 25, 26, 30 and 31 are rejected under 35 U.S.C. 103(a) as obvious over Plunkett et al. (US Re. 36,247) and Blanc et al. (Clinical Therapeutics, 1998), 20(5), 901-912). Both the references teach the art, which embraces instantly, claimed invention. See the entire documents, especially cited below.

1. Determining the scope and contents of the prior art.

Plunkett teaches a method of hormonal treatment for menopausal disorders involving continuous administration of progestogens and estrogens. See the entire document especially lines 40-51, col. 2; lines 63-67, col. 2; lines 1-67, col. 3; lines 18-25, and lines 1-5, col. 4; lines 46-50, col. 6.

The reference teaches continuous and uninterrupted administration of progestogen and estrogen. The actual unit dosage are selected according to conventionally known methods, e.g. body weight of patient and biological activity of hormones with the ultimate goal of producing the desired result with minimum quantities of hormones. It does not disclose specifically nomegesterol acetate.

Blanc et al teaches continuous hormone replacement therapy combining nomegesterol acetate and gel, patch or oral estrogen. See the abstract of the invention; cols 1 and 2 on page 903col. 2 on page 904Table 1 on page 905Figure on page 906 ; Table II on page 907. Prior art also teach that bleeding occurs when treatment is discontinued.

2. Ascertaining the differences between the prior art and the claims at issue.

Instant claims are drawn to a method of treating deficiencies of estrogen by continuously administering a combination of estrogen and nomagesterol acetate. Blanc et al. teach the same combination, the ranges of the amounts overlap with the prior art teaching. Prior art teaches estradiol, 2 mg/dose whereas presently claimed amount is 0.3-3 mg and nomegesterol 2.5 mg/d whereas presently claimed amount 0.3 to 1.25 mg. The Plunkett et al differs from the instant invention in that it does not specifically name nomegesterol acetate. Presently claimed invention does not clearly state what is the amount of the steroids per dose per day.

3. Resolving the level of ordinary skill in the pertinent art.

It would be obvious to one skilled in the art at the time of invention to prepare a composition to administer

continuously combination of estrogen and nomegesterol as cited above.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Motivation is to use estrogen and progestogen continuously as taught by Plunkett et al. and use nomegesterol as progestagen because it gives in all patients regular, progestogen-induced withdrawal bleed each month; and histological, ultra structural and biochemical changes were induced within the endometrium by all doses (0.5 mg, 1.0 mg; and 2.5 mg) is a potent

progestogen. Blanc et al. teach same combination as combination of nomegestrol and estradiol. Thus, there has been ample motivation provided by the teachings of both the references cited above to prepare the instant invention in absence of any criticality or unexpected results.
Claim 31 is drawn to composition and Examiner would like to emphasize that the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau,* 57 USPQ 324; *Ex parte Douros,* 163 USPQ 667; and *In re Craige,* 89 USPQ 393.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

The declaration was considered very carefully. The arguments are confusing, the data in Table 1 and 4 is for application no. 09/284,147 and not this application which is 09/423,109; Table 2 is Fraser's' data, the statements in Table 3 is a known and is nothing to do with the presently claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SABIHA QAZI, PH.D
PRIMARY EXAMINER

Monday, July 25 2005